

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re: Application Serial No. 85/324,443
For the Mark: COLOR WARS
Filed: May 18, 2011
Published in the Official Gazette: January 17, 2012

Ennis, Inc.

Opposer

v.

Joel L. Beling d/b/a Supa Characters Pty Ltd

Applicant

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) Opp. No. 91203884
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APPLICANT'S MOTION TO DIVIDE

To: Trademark Trial and Appeal Board

To: Ennis Inc. 2441 Presidential Parkway, Midlothian, TX 76065, United States.

1. Applicant moves to divide all goods and services in classes 28 and 41 in the above application from all goods and services in class 16. The effect of this would be that Applicant would be free to proceed with the registration of his COLOR WARS mark in classes 28 and 41, while the goods and services listed in class 16 would remain opposed by Opposer.
2. Please see Exhibits 1 (this document) and 2 (attached) regarding Opposer's Consent to so Divide Applicant's Application.

APPLICANT'S MOTION TO DIVIDE



07-18-2012

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3. If and when this Motion is granted by the Board, Applicant will pay the relevant divisional fee of \$100 only, or Board can bill my already submitted credit card for \$100 only.
4. Applicant files this Motion because Opposer's Opposition is significantly disrupting his endeavors to bring his superhero character licensing business to market. Moreover, it appears that, with respect to Applicant's class 41 goods and services, Opposer has opposed this class without a good faith basis and now wishes to withdraw its Opposition in respect of this class without adducing evidence.

PRAYER

WHEREFORE, premises considered, Applicant prays that the Trademark Trial and Appeal Board divide Opposition No. 91203884 so that the goods and services listed in classes 28 and 41 are free to proceed to registration and that the goods and services listed in class 16 remain opposed by Opposer, such Opposition to be determined on the merits by the Board.

Dated: July 13, 2012

Respectfully submitted,

By: /Joel Beling/

Joel L. Beling
1 Mirboo Court
Dallas, Victoria, 3047
Australia
(03) 8307 6932 (telephone)
0405 329 078 (cell)
joelbeling@hotmail.com
Applicant

Exhibit 1

***RE: Petitioner's Initial Disclosures: COLORWORX
Cancellation Petition***

9/07/2012

To joel beling, Cynthia Minchillo, Scott Meyer

From: **Tom Jacks** (tjacks@chalkerflores.com)

Sent: Monday, 9 July 2012 6:41:21 PM

To: joel beling (joelbeling@hotmail.com)

Cc: Cynthia Minchillo (cminchillo@chalkerflores.com); Scott Meyer
(smeyer@chalkerflores.com)

Joel,

As I stated in my email to you July 6, 2012, we do not consent to receiving your document production in the Opposition as your document production in the Cancellation. By your request, the matters are separate. Also, please see our letter to you on June 21, 2012 for the information related to the classes, goods and services.

As always, please let me know if you have any questions or would like to discuss this matter on the phone.

Tom

Thomas G. Jacks | Chalker Flores, LLP

14951 North Dallas Parkway, Suite 400 | Dallas, Texas 75254
Main: 214-866-0001 | Direct: 214-445-4021 | Fax: 214-866-0010
tjacks@chalkerflores.com | www.chalkerflores.com

From: joel beling [mailto:joelbeling@hotmail.com]

Sent: Sunday, July 08, 2012 11:17 PM

To: Tom Jacks

Cc: Cynthia Minchillo; Scott Meyer

Subject: RE: Petitioner's Initial Disclosures: COLORWORX Cancellation Petition

Scott,

Do you mind sending me a list of the classes and goods and services you do oppose and those you don't by 5pm Tuesday, CST time?

Also, do you consent to receiving my document production in the Opposition as my document production for the Cancellation?

Thank you

Joel

CHALKER FLORES, LLP

**FOR SETTLEMENT PURPOSES ONLY
PURSUANT TO FRE 408**

June 21, 2012

Via Electronic Mail

Joel L. Beling
1 Mirboo Court
Dallas, Victoria 3047
Australia

Re: *Ennis, Inc. v. Joel L. Beling d/b/a Supa Characters Pty Ltd*
Opposition No. 91203884, USPTO Trademark Trial and Appeal Board

Dear Joel:

We will respond to the various correspondence you have sent to us regarding discovery issues under separate cover. However, as we have expressed to you previously, our client understands your desire to resolve the dispute peacefully, quickly, and at a minimum of expense. Ennis, Inc. does not wish for you to have difficulty pursuing your superhero character endeavor. However, many of the goods and services you identify in your application are much broader than your stated intentions regarding your business. Additionally, many of the goods and services you have listed cross into the goods and services associated with the COLORWORX® trademark and present a likelihood of confusion to consumers. If you are willing to amend the following specific goods and services you identified in your application, we believe the dispute can be resolved quickly and both parties can put this matter behind them.

If you agree to add the italicized language to the following goods and services clarifying your usage, we think we can resolve the matter:

- a) color prints *involving superhero and cartoon characters*;
- b) envelopes for stationery use *involving superhero and cartoon characters*;
- c) file pockets *involving superhero and cartoon characters*;
- d) graphic prints and representations *involving superhero and cartoon characters*;
- e) office paper stationery *involving superhero and cartoon characters*;
- f) office stationery *involving superhero and cartoon characters*;
- g) planning folders *involving superhero and cartoon characters*;
- h) paper stationery *involving superhero and cartoon characters*;

Scott A. Meyer, PC
14951 N. Dallas Parkway, Suite 400
Dallas, Texas 75254

Tel: 214.866.0001
Fax: 214.866.0010
smeyer@chalkerflores.com

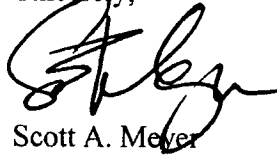
CHALKER FLORES, LLP

- i) paper stationery with inspirational messages imprinted thereon *involving superhero and cartoon characters*;
- j) partially printed forms *involving superhero and cartoon characters*;
- k) pictorial prints *involving superhero and cartoon characters*;
- l) printed calendars *involving superhero and cartoon characters*;
- m) printed certificates *involving superhero and cartoon characters*;
- n) printed certificates for sports and/or entertainment fans *involving superhero and cartoon characters*;
- o) printed certificates in the field of sports and/or entertainment *involving superhero and cartoon characters*;
- p) printed collector cards made primarily of paper and also including metal *involving superhero and cartoon characters*;
- q) printed collector cards made primarily of paper but also including metal *involving superhero and cartoon characters*;
- r) printed emblems *involving superhero and cartoon characters*;
- s) printed forms *involving superhero and cartoon characters*;
- t) printed graphs *involving superhero and cartoon characters*;
- u) printed greeting cards with electronic information stored therein *involving superhero and cartoon characters*;
- v) printed holograms *involving superhero and cartoon characters*;
- w) printed material in the nature of color samples *involving superhero and cartoon characters*;
- x) printed materials *involving superhero and cartoon characters*, namely, curricula in the field of superhero and cartoon;
- y) printed paper labels *involving superhero and cartoon characters*;
- z) printed paper sign printed patterns *involving superhero and cartoon characters*;
- aa) printed periodicals *involving superhero and cartoon characters* in the field of movies;
- bb) printed periodicals *involving superhero and cartoon characters* in the field of music;
- cc) printed periodicals *involving superhero and cartoon characters* in the field of plays;
- dd) printed periodicals *involving superhero and cartoon characters* in the field of tourism;
- ee) printed wine and beer bottle labels incorporating a feature that changes color in response to fluctuation in temperature of the contents of the bottle to which the label is affixed *involving superhero and cartoon characters*;
- ff) prints *involving superhero and cartoon characters*;
- gg) stationery *involving superhero and cartoon characters*;
- hh) stationery boxes *involving superhero and cartoon characters*;
- ii) stationery cases *involving superhero and cartoon characters*;
- jj) stationery folders *involving superhero and cartoon characters*;
- kk) stationery writing paper and envelopes *involving superhero and cartoon characters*;
- ll) stationery-type portfolios *involving superhero and cartoon characters*; and
- mm) stickers *involving superhero and cartoon characters*.

CHALKER FLORES, LLP

We would like to schedule a time to speak with you and walk through each of the goods and services we have identified in this letter to determine if we can find some common ground. As such, please let us know when you might be able to schedule such a conference. We look forward to hearing from you.

Sincerely,



Scott A. Meyer

SAM/cm

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S MOTION TO DIVIDE was served on all parties, this the 13th day of July, 2012, by sending the same electronic mail, to the following:

Scott A. Meyer
Thomas Jacks
CHALKER FLORES, LLP
smeyer@chalkerflores.com
tjacks@chalkerflores.com
ATTORNEYS FOR OPPOSER

/JOEL BELING/
JOEL BELING

CERTIFICATE OF MAILING

Opposition No.: 91203884

I hereby certify that this Applicant's Motion to Divide is being deposited with Australia Post in an envelope addressed to: Commissioner for Trademarks, PO Box 1451, Alexandria, Virginia 22313-1451 on the date shown below.

JOEL BELING



13 July 2012